

ESTTA Tracking number: **ESTTA82508**Filing date: **05/25/2006**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	PRIMEPAY, INC.		
Entity	Corporation	Citizenship	VIRGINIA
Address	596 LANCASTER AVENUE MALVERN, VA 19355 UNITED STATES		
Attorney information	Mark Lebow Young & Thompson 745 South 23rd Street Suite 200 Arlington, VA 22202 UNITED STATES mlebow@young-thompson.com Phone:703-521-2297		

**Registration Subject to Cancellation**

Registration No	2715127	Registration date	05/13/2003
Registrant	Primepoint, L.L.C. 163 Route 130, Building IC Bordentown, NJ 08504 UNITED STATES		
Goods/Services Subject to Cancellation	Class 036. First Use: 2000/12/00 , First Use In Commerce: 2000/12/00 Goods/Services: Financial services, namely banking and payroll services		
Related Proceedings	Civil Case No. 06-CV-01551 (FLW) in the United District Court for the District of New Jersey.		
Attachments	Petition for Cancellation.pdf ( 8 pages )(25809 bytes )		
Signature	/Mark Lebow/		
Name	Mark Lebow		
Date	05/25/2006		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PRIMEPAY, INC.,

Petitioner,

v.

PRIMEPOINT, L.L.C.,

Respondent.

Cancellation No.

In re: U.S. Trademark  
Registration No. 2715127

NOTICE OF OPPOSITION

Petitioner, PRIMEPAY, INC., is a Virginia corporation with offices located at 596 Lancaster Avenue, Malvern, Pennsylvania 19355.

Respondent, PRIMEPOINT, L.L.C., is a New Jersey limited liability company with offices located at 163 Route 130, Building IC, Bordentown, New Jersey 08504.

Petitioner believes that it will be damaged by registration of the mark PRIMPOINT and Design as shown in Registration No. 2715127 for services in International Class 35 and hereby opposes the same.

The grounds for cancellation are as follows:

COUNT I - LIKELIHOOD OF CONFUSION

1. Petitioner has used its mark PRIMEPAY in commerce on or in connection with business and financial management services, including payroll services, in commerce since as early as August 1995 and, in any event, prior to any use of the mark PRIMPOINT by Respondent.
2. Petitioner has used the mark PRIMELINK in commerce on or in connection with computer software for transmission of payroll and/or employee data since as early as July 1995 and, in any event, prior to any use of the mark PRIMEPOINT by Respondent.
3. Petitioner has used the mark PRIMETAX in commerce on or in connection with tax payment processing services and/or payroll tax debiting services since as early as July 1995 and, in any event, prior to any use of the mark PRIMEPOINT by Respondent.
4. Petitioner intends to continue use of the marks PRIMEPAY, PRIMELINK and PRIMETAX (hereafter referred to as the "PRIMEPAY family of marks") in connection with the services recited in numbered paragraphs 1-3 above.

5. As a result of its continuous and exclusive use of the PRIMEPAY family of marks in commerce on or in connection with the services recited in numbered paragraphs 1-3 above, Petitioner has developed substantial good will.
6. As a result of the high quality of the services it provides under the PRIMEPAY family of marks, Petitioner has garnered a valuable reputation.
7. Furthermore, Petitioner has developed substantial common law rights in its PRIMEPAY family of marks.
8. On May 13, 2003, Respondent obtained U.S. Registration No. 2715127 for the mark PRIMEPOINT and Design for "financial services, namely, banking and payroll services" in International Class 36, on the basis of use in commerce, alleging a date of first use of its mark in commerce on or in connection with the recited services since as early as December 2000.
9. Priority is not an issue. Applicant's use of its PRIMEPAY family of marks precede Respondent's claimed date of first use of its mark PRIMPOINT and Design as alleged in Registration No. 2715127.

10. Respondent's Registration No. 2715127 for the mark PRIMEPOINT is closely similar in appearance, connotation, sound and/or commercial impression to Petitioner's family of marks recited in numbered paragraphs 1-3 above.
11. The services recited in Registration Serial No. 2715127 are closely related to and/or are overlapping with Petitioner's services recited in numbered paragraphs 1-3 above.
12. Upon information and belief, Petitioner avers that the services described in Registration Serial No. 2715127 are advertised and provided in similar channels of trade and to similar customers as Petitioner's services.
13. Respondent's use of the mark PRIMPOINT and Design in connection with the services described in Registration No. 2715127 interferes with Petitioner's use of its PRIMEPAY family of marks and is likely to cause the public to believe that the services of Respondent originate with Petitioner, or vice versa, or that Respondent is owned or controlled by or in some manner affiliated or associated with Petitioner, or vice versa,

and is otherwise likely to cause confusion, cause mistake or deceive.

14. Any defect, inadequacy or deficiency found in Respondent's services marketed, sold or otherwise provided under the PRIMPOINT and Design mark would reflect negatively upon and seriously injure the reputation and goodwill associated with the services rendered by Petitioner in connection with its PRIMEPAY family of marks.

15. If Respondent were permitted to maintain its registration, it would continue to have at least a prima facie exclusive right to use the mark PRIMPOINT and Design mark. Such continued registration would be a source of damage and injury to Petitioner and its customers.

#### COUNT II - FRAUD

16. Petitioner repeats and realleges the allegations set forth in paragraphs 1 through 15 herein.

17. On August 7, 2001, Respondent filed the trademark application that resulted in Registration No. 2715127 for the mark PRIMEPOINT and Design covering the

ultimately recited services "financial services, namely, banking and payroll services" in International Class 36 (hereafter "Respondent's underlying application").

18. Respondent's underlying application was filed on the basis of use in commerce under Section 1(a) of the Trademark Act.
19. Upon information and belief, Respondent is not a bank.
20. Although Respondent may provide services to banking clients, Respondent has never itself provided banking services.
21. Upon information and belief, Respondent has never used the mark PRIMPOINT and Design mark in commerce on or in connection with banking services.
22. Upon information and belief, and notwithstanding its knowledge that the mark PRIMPOINT and Design had never been used in commerce in connection with banking services, Respondent's in its underlying application claimed it had been using its mark in connection with banking services for purposes of deceiving the USPTO in order to procure a registration for a mark that included "banking services".

23. On the basis of the actions pleaded in the immediately preceding paragraphs, Respondent has committed fraud against the U.S. Patent and Trademark Office in the procurement of its registration.

WHEREFORE, Petitioner prays that Registration No. 2715127 will be cancelled and that this cancellation be sustained in favor of Petitioner.

The fee of \$300.00 pursuant to 37 C.F.R. § 2.6(a)(17) is being paid pursuant to the electronic filing of this Petition for Cancellation. However, if the fee paid is insufficient, please charge our debit account no. 25-0120.

Petitioner has appointed Mark Lebow, Douglas Rigler, Robert J. Patch, Andrew J. Patch, Benoît Castel, Thomas W. Perkins, Eric Jensen, and Roland E. Long, Jr., all of whom are affiliated with the firm Young & Thompson, 745 South 23rd Street, Arlington, Virginia 22202, as its duly authorized agents and attorneys in the matter of this opposition, with full power of substitution and revocation, to transact all business with the Patent and Trademark Office and elsewhere in the United States courts in connection with this opposition, to sign all papers which may be hereinafter filed in connection



with this opposition, and to receive all communications relating to this cancellation.

Respectfully submitted,

/Mark Lebow/

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Attorney for Petitioner

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May 25, 2006